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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,280	11/12/2003	Patrick Guiney	11.037011 US	9311
41696 7590 10/28/2008 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070				
			EXAMINER	
			HYUN, PAUL SANG HWA	
		ART UNIT	PAPER NUMBER	
		1797		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,280

Applicant(s)

GUINEY, PATRICK

Examiner

PAUL S. HYUN

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-6, 9-19, 21, 23, 25-42 and 59-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 9-19, 21, 23, 25-42 and 59-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. In the interview conducted on September 15, 2008, it was brought to the Examiner's attention that the Morrison reference that was cited as prior art in the previous Office action had been antedated by a 1.131 Declaration filed on June 11, 2007. Consequently, the rejections citing the Morrison reference are no longer tenable and they have been withdrawn.

The Declaration under 1.131 resubmitted by Applicant has been acknowledged.

Claims 1, 2, 4-6, 8-16, 18, 19, 21-23, 25-42 and 59-69 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1, 4, 11, 12 and 16** are rejected under 35 U.S.C. 102(e) as being anticipated by Somack et al. (US 2003/0098271 A1).

Somack et al. disclose a sample tray 50 configured to be processed by a work station (see [0010]). The tray comprises an array of apertures wherein a cylindrical filter membrane 54 for immobilizing a sample (e.g. blood, tissue, microorganisms) is positioned in each aperture (see Fig. 7). The tray can comprise a bar code associated

with each aperture for storing data related to the filter, such as the type of filter used to immobilize the sample and the test to be performed on the sample (see [0009] and [0060]).

With respect to claim 16, it is evident that each bar code comprises a unique registration number. Otherwise, the bar code reader would not be able to identify and distinguish each bar code.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **2, 9, 10, 59-65 and 67-69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. (US 6,136,274) and Marsh et al. (US 5,219,294).

Somack et al. do not disclose a data storage device that is positioned in a recess.

Nova et al. disclose a microplate comprising an integrated memory (see lines 29-44, col. 14). The memory device can be integrated into the microplate for storing data related to each well. The memory can be in the form of a bar code (see line 11, col. 22), a RAM (see line 64, col. 21) or a programmable ROM (see line 35, col. 20). Marsh et al.

disclose a parallel port connector for interfacing two electrical devices (e.g. computer and printer). The connector comprises a symmetrical recess comprising tapered surfaces 38a and 38b to ensure a solid physical connection (see Figs 1 and 6 and line 51, col. 3).

In light of the disclosure of Nova et al., it would have been obvious to one of ordinary skill in the art to provide the tray disclosed by Somack et al. with an electronic memory, such as a RAM or a ROM, instead of a bar code, so that information to and from the work station can be updated quickly. In light of the disclosure of Marsh et al., it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with the serial connection disclosed by Marsh et al. so that the tray can be securely docked with a work station.

With respect to claims 67 and 68, Somack et al. do not explicitly disclose that the data storage can store information such as the number/parameters of processing steps involving the filter. However, the reference does disclose that the bar codes can store information directed towards the intended application of each sample and filter (see [0009]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to store the procedural steps for accomplishing the intended application in the memory so that the intended applications can be automated.

With respect to claim 69, although Somack et al. do not explicitly disclose that each data comprises a unique registration number, it would have been obvious to provide individual data with a unique registration number so that the memory can identify and distinguish each data.

Claim **13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Crosby (US 6,770,487 B2).

Somack et al. do not disclose that the information stored in the bar code includes the expiration date of the filter medium.

Crosby discloses an absorbent medium for collecting a biological sample thereon. The absorbent medium further comprises a bar code wherein one of the information stored in the bar code is the expiration date of the absorbent medium (see lines 10-15, col. 4). In light of the disclosure of Crosby, it would have been obvious to one of ordinary skill in the art to store in the bar codes the expiration date of each filter medium disclosed by Somack et al. to ensure proper preservation of the samples.

Claims **14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al.

With respect to claims 14 and 15, Somack et al. do not explicitly disclose that the bar codes can store information such as the number/parameters of processing steps involving the filter. However, the reference does disclose that the bar codes can store information directed towards the intended application of each sample and filter (see [0009]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to store the procedural steps for accomplishing the intended application in each bar code so that the intended applications can be automated.

With respect to claim 16, although Somack et al. do not explicitly disclose that each bar code comprises a unique registration number, it would have been obvious to provide each bar code with a unique registration number so that the bar code reader can identify and distinguish the bar codes.

Claims **5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al.

Somack et al. do not disclose the use of read only memory (ROM) or a read/write memory.

Nova et al. disclose a microplate comprising an integrated memory (see lines 29-44, col. 14). The memory device can be integrated into the microplate for storing data related to each well. The memory can be in the form of a bar code (see line 11, col. 22), a RAM (see line 64, col. 21) or a programmable ROM (see line 35, col. 20). In light of the disclosure of Nova et al., it would have been obvious to one of ordinary skill in the art to provide the tray disclosed by Somack et al. with an electronic memory, such as a RAM or a ROM, instead of a bar code, so that the information can be quickly communicated to and from a work station.

With respect to claims 33 and 34, Somack et al. do not explicitly disclose that the bar codes can store information such as the number/parameters of processing steps involving the filter. However, the reference does disclose that the bar codes can store information directed towards the intended application of each sample and filter (see [0009]). In light of the disclosure, it would have been obvious to one of ordinary skill in

the art to store the procedural steps for accomplishing the intended application in the memory so that the intended applications can be automated.

With respect to claim 35, although Somack et al. do not explicitly disclose that each data comprises a unique registration number, it would have been obvious to provide individual data with a unique registration number so that the memory can identify and distinguish each data.

With respect to claims 39 and 40, Somack et al. disclose another embodiment of the invention comprising a tray for receiving vials 8 (see Fig. 2). The reference discloses that the vials can comprise bar codes that correspond to bar codes assigned to each aperture in the tray so that the correct vials can be inserted into each aperture of the tray (see [0060]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with vials comprising data storage means that correspond to the apertures of the modified tray so that the transfer of samples stored in vials to the tray can be automated.

Claims **25-28, 36 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. as applied to claims 5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41 and 43, and further in view of Marsh et al.

Neither Somack et al. nor Nova et al. explicitly disclose how the memory is accessed.

Marsh et al. disclose a parallel port connector for connecting two electrical devices (e.g. computer and printer). The connector comprises a symmetrical recess

comprising tapered surfaces 38a and 38b to ensure a solid physical connection (see Figs 1 and 6 and line 51, col. 3). In light of the disclosure of Marsh et al., it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with a serial connection disclosed by Marsh et al. so that the tray can be securely docked with a work station.

Claim **32** is rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. as applied to claims 5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41 and 43, and further in view of Crosby.

Neither Somack et al. nor Nova et al. disclose that the information stored in the memory includes the expiration date of the filter medium.

Crosby discloses an absorbent medium for collecting a biological sample thereon. The absorbent medium further comprises a bar code wherein one of the information stored in the bar code is the expiration date of the absorbent medium (see lines 10-15, col. 4). In light of the disclosure of Crosby, it would have been obvious to one of ordinary skill in the art to store in the memory the expiration date of each filter medium of the modified Somack et al. tray to ensure proper preservation of the samples.

Claims **38 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. as applied to claims 5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41 and 43, and further in view of McDevitt et al. (US 2002/0045272 A1).

Neither Somack et al. nor Nova et al. disclose a wireless interface or an electro-optical interface.

McDevitt et al. disclose a sample container that is capable of interfacing with a testing apparatus. The container can communicate with the testing apparatus wirelessly or by means of infrared sensors (see [0558]). In light of the disclosure of McDevitt et al., it would have been obvious to one of ordinary skill in the art to interface the modified Somack et al. tray with the work station wirelessly or by means of infrared sensors.

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. and Marsh et al. as applied to claims 2, 9, 10, 59-65 and 67-69, and further in view of Crosby.

None of Somack et al., Nova et al. and Marsh et al. disclose that the information stored in the memory includes the expiration date of the filter medium.

Crosby discloses an absorbent medium for collecting a biological sample thereon. The absorbent medium further comprises a bar code wherein one of the information stored in the bar code is the expiration date of the absorbent medium (see lines 10-15, col. 4). In light of the disclosure of Crosby, it would have been obvious to one of ordinary skill in the art to store in the memory the expiration date of each filter medium of the modified Somack et al. tray to ensure proper preservation of the samples.

Response to Arguments

Applicant's arguments with respect to the Somack et al. reference have been fully considered but they are not persuasive.

Applicant argues that the disclosure of the Somack et al. directed towards bar codes has been mischaracterized. Specifically, Applicant argues that the bar coded "devices" referred to in said disclosure are directed toward tubular capsules, not a tray. Therefore, Applicant argues that Somack et al. do not disclose a sample tray comprising a data storage device. This argument is not persuasive because the reference discloses multiple embodiments wherein the "device" is a tray comprising integrated filters in one embodiment (see Fig. 7 and [0008]). Specifically, the reference discloses "reaction device is provided in the form of a plate system". Although the term "devices" refers to capsules, it is apparent from the disclosure that the term refers to the tray illustrated in Figure 7 as well. Therefore, the Examiner maintains the position that the passages of Somack et al. directed towards bar codes are applicable to the plate system 50 illustrated in Figure 7.

Applicant also argues that system 50 shown in Figure 7 of the Somack et al. reference does not constitute a tray. Specifically, Applicant argues that the reference refers to system 50 as a "plate system", and not a "tray" as claimed. This argument is not persuasive because the distinction raised by Applicant is nominal in nature. The fact that the reference refers to system 50 as a "plate" and not a "tray" does not mean that system 50 disclosed by the reference is not a tray. As illustrated in Figure 7 of the Somack et al. reference, plate system 50 is shaped like a flat and rectangular, and

comprises all the claimed limitations, namely a plurality of apertures for collecting biological samples and a data storage device.

Applicant also argues that the passages of the Somack et al. reference cited in the rejection are directed towards the capsular embodiment, not the tray embodiment. Specifically, Applicant argues that [0010] of Somack et al. describes the intended use of the capsules, not system 50 that was cited in the rejection. This argument is not persuasive because [0010] of the reference is describing the intended use of the tray embodiment, as explained above (device=plate system 50). Moreover, it is apparent that the passages directed toward the application/intended use are applicable to all embodiments. That said, the Examiner maintains the position that [0010] of the reference describing automated processing is applicable to system 50. For the foregoing reasons, Applicant's arguments with respect to the Somack et al. reference are not persuasive.

Applicant's argument with respect to the Crosby reference has been fully considered but it is not persuasive.

Applicant argues that while Crosby discloses a test strip for performing a diagnostic test wherein the test strip comprises a bar code for storing an "expiration date", it is unclear what the "expiration date" refers to. Therefore, Applicant argues, there is no motivation to store the expiration date of a filter in the bar code disclosed by Somack et al. This argument is not persuasive. Despite the ambiguity, the disclosure of Crosby is sufficient to motivate one of ordinary skill in the art to incorporate the relevant expiration date into the bar code disclosed by Somack et al. In this instance, it would

have been obvious to ordinary skill in the art to incorporate the expiration date of the filter into the bar code disclosed by Somack et al. For the foregoing reason, Applicant's argument with respect to the Crosby reference is not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/
Examiner, Art Unit 1797

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797